

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marsu N.V.

Serial No. 74/083,403

B. Allison Hoppert, Raymond A. Kurz and G. Franklin Rothwell of
Rothwell, Figg, Ernst & Kurz, P.C. for Marsu N.V.

Loretta C. Beck, Trademark Examining Attorney, Law Office 102
(Thomas V. Shaw, Acting Managing Attorney).

Before Hanak, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Marsu N.V. has filed an application to register the
design, reproduced below,

of an animal-like character, which it calls "MARSUPILAMI" (hereinafter "MARSUPILAMI design"), for the following goods: "paper bags, greeting cards, decals, gift wrapping paper, paper napkins, pencils, posters, stationery and paper tablecloths" in International Class 16; "cups, paper and decorative plates, [and] mugs" in International Class 21; "outer clothing, namely, shirts, [and] footwear" in International Class 25; and "dolls, toys, jig saw puzzles, stuffed toys, games featuring fictional cartoon characters and video-game machines" in International Class 28.¹

Registration has been finally refused on the basis that the drawing of the mark is not a substantially exact representation of the mark as used on or in connection with applicant's goods² and that, since any amendment of the drawing would constitute a material alteration thereof,³ submission of

¹ Ser. No. 74/083,403, filed as an intent-to-use application on July 31, 1990 and indicating that "[t]he mark is lined for the colors red and yellow which are claimed as features of the mark." Following issuance of a notice of allowance on June 2, 1992, applicant submitted a statement of use on July 14, 1994 which alleges the following dates of first use: June 1993 for "pencils" in International Class 16, "mugs" in International Class 21 and "stuffed toys" in International Class 28"; and December 1, 1993 for "footwear" in International Class 25.

² Trademark Rule 2.51(a)(2) provides in pertinent part that:

In a application under §1(b) of the [Trademark] Act, the drawing of the trademark shall be a substantially exact representation of the mark as intended to be used on or in connection with the goods specified in the application, and once ... a statement of use under §2.88 has been filed, the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods

³ In this regard, Trademark 2.72(a) specifies that:

Amendments may not be made to the ... drawing of the mark if the character of the mark is materially altered. The determination of whether a proposed amendment materially alters the character of the mark will be made by

substitute, properly verified specimens showing use of the MARSUPILAMI design as a trademark for such goods is required.⁴

Applicant has appealed. Briefs have been filed,⁵ but an oral hearing was not requested. We affirm the refusal to register and the concomitant requirement for properly verified substitute specimens.

Applicant, citing the Board's interpretation of Trademark Rule 2.51(a)(3)⁶ in *United Rum Merchants Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481, 1483 (TTAB 1988), argues that Trademark Rule 2.51(a)(2) should likewise be read so that

comparing the proposed amendment with the ... drawing of the mark as originally filed.

⁴ Trademark Rule 2.59(b) states in relevant part that:

In an application under §1(b) of the [Trademark] Act, after filing ... a statement of use under §2.88, the applicant may submit substitute specimens of the mark as used on or in connection with the goods ... provided that the use in commerce of any substitute specimens submitted is supported by applicant's affidavit or declaration in accordance with §2.20. In the case of a statement of use under §2.88, the applicant must verify that the substitute specimens were in use in commerce prior to the filing of the statement of use or prior to the expiration of the time allowed to applicant for filing a statement of use.

See also TMEP §905.10.

⁵ Although the Examining Attorney also finally refused registration on the basis that "the proposed mark is ornamental" as used on the goods in International Classes 16 and 21, the Examining Attorney states in her brief that, "[u]pon further consideration," she "withdraws the ornamentation refusal" and that, accordingly, "the only issue on appeal is whether the mark depicted on the specimens matches the proposed mark as depicted in the drawing."

⁶ Such rule currently provides that:

In an application under §44 of the [Trademark] Act, the drawing of the trademark shall be a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the country of origin of the applicant.

"the phrase 'substantially exact' means 'materially the same,' not exactly the same." Applicant maintains that, when Trademark Rule 2.51(a)(2) is so construed, it is in compliance therewith since (underlining in original):

While there are slight differences in the form in which the [marks shown on the] specimens are depicted, it is, in fact the same character which appears in the specimens and [in] the drawings [sic]. The drawing of the MARSUPILAMI design as filed consisted of the unique spotted MARSUPILAMI character having a long spiral tail. The specimens as filed [with the statement of use] show substantially the exact same spotted MARSUPILAMI animal with a long spiral tail. The tail merely is twisting in a slightly different direction; the MARSUPILAMI animal is posed at a slightly different angle; and the flower present in the drawing has been removed. The specimens show the same character as presented in the drawing; the character is simply presented in a different pose. Therefore, even given these minor alterations, the drawing as filed and the mark as used in the specimens create materially the same commercial impression.

In no way do these minor alterations rise to the level of creating a new mark. Just as a "Mickey Mouse" or "Snoopy" character may appear in different positions, those characters, regardless of the physical position in which the character is depicted, would always be recognized as the same character. Here, the MARSUPILAMI character is the same essential character. Indeed, all of the character's physical features are virtually identical in each of the depictions of the character. Certainly, customers encountering the character on the specimens would recognize that all of the specimens depict the same character. Customers would also recognize that the character on the specimen is the same character as is in the drawing. As such, any differences are non-material in nature and do not affect the ability of the character to be recognized as emanating from a single source.

While we agree with applicant that the phrase "substantially exact representation" in Trademark Rule 2.51(a)(2) should be construed as meaning "materially the same," we concur with the Examining Attorney, however, that the MARSUPILAMI design shown in the drawing does not meet such standard⁷ inasmuch as it is not materially the same as the various representations of applicant's "MARSUPILAMI" character which are shown on the specimens of use. Examples of the manner in which the "MARSUPILAMI" character is used on the specimens are reproduced below:

Specimens for International Class 16

Specimens for International Class 21

⁷ The substantially exact representation standard, as the Examining Attorney correctly points out, is a subjective determination. See e.g., In re R. J. Reynolds Tobacco Co., 222 USPQ 552 (TTAB 1984).

Specimens for International Class 25

Specimens for International Class 28

As the Examining Attorney accurately notes, the MARSUPLIAMI design shown in the drawing "displays a spotted character having a long twisting tail with a flower jutting out of its mouth and its hands perched in front of it." By contrast, "[n]one of the specimens display[s] the mark as depicted in the drawing" and, as further noted by the Examining Attorney, while "[t]he marks on the specimens display a spotted character, its arms are outstretched and are hanging from a branch, the tail is twisting in various directions, and the flower is removed from its mouth."

In view thereof, the Examining Attorney maintains that (underlining in original):

Although the substantially exact representation standard does allow some immaterial differences between the drawing

and the specimens, the marks on all the specimens differ considerably from the mark as depicted in the drawing. These differences, namely, the different poses, the various tail twists, and the omission of the flower, are material. The cumulative effect of these differences creates marks with different commercial impressions.

....

All of the elements of the depicted marks [on the specimens], not just the ["MARSUPILAMI"] character, must be considered in determining the commercial impression of [each of] the mark[s]. Thus, although the character may share some features in each of the depictions, the marks, as a whole, create different commercial impressions. Based on these material differences, the drawing of the trademark is not a "substantially exact representation" of the mark as it appears on [each of] the specimens.

The applicant is seeking broad protection for several marks, namely, that depicted in the drawing and those depicted in the specimens. An applicant, however, may apply to register only one mark in each application. *In re Audi NSU Auto Union AG*, 197 USPQ 649 (TTAB 1977); *In re Jordan Industries, Inc.*, 210 USPQ 150 (TTAB 1980); TMEP Sections 807 and 1113.01. Since the marks on the specimens differ from the drawing to the extent that they create different commercial impressions, the drawing in the application is not a "substantially exact representation" of the mark.

Assuming, without deciding, that as utilized on the hang tags and products themselves, the specimens demonstrate trademark use of the "MARSUPILAMI" character and not mere ornamentation, none of the various depictions of the "MARSUPILAMI" character on the specimens is materially the same as the MARSUPILAMI design shown in the drawing. Not one of the specimens includes the presence of any prominent flower in the

character's mouth, much less a substantially exact representation of the blossom or bloom illustrated in the drawing. Similarly, not one of specimens depicts even a similar pose or expression for the "MARSUPILAMI" character, much less a stance or countenance which is materially the same as that shown in the drawing. Consequently, while perhaps recognizable as the same *character*, the MARSUPILAMI design in the drawing is not materially the same *mark* as any of the various illustrations of the "MARSUPILAMI" character on the specimens,⁸ and hence is not a substantially exact representation of such mark, since the former does not project essentially the same overall commercial impression as that imparted by any of the latter. Trademark Rule 2.51(a)(2). Properly verified substitute specimens demonstrating use of the MARSUPILAMI design as a trademark for applicant's

⁸ As the Board has observed in another case involving an attempt to register an animal character design as a mark:

[F]ictitious or fanciful characters may function to identify and distinguish the source of goods or services. See, e.g., *In re DC Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394 (CCPA 1982) and *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984). Nevertheless in order to be registrable, the use of such a character, however arbitrary it may be in its conception, must be perceived by the purchasing public not just as a character but also as a mark which identifies and distinguishes the source of the goods or services.

In re Hechinger Investment Co. of Delaware, Inc., 24 USPQ2d 1053, 1056 (TTAB 1991) ["commercial impression created by ... use of a dog design in different poses and contexts is clearly and simply that of a fanciful dog character named "Twobafor" which appears in certain illustrations in applicant's advertisements"; moreover, inasmuch as "the specific dog design sought to be registered--that for a fanciful hound leaning on its front paws with its tail in the air--exclusively appears in the specimens originally submitted and not in any other advertisements ..., none of the specimens demonstrate[s] that the dog design applicant seeks to register functions as a service mark for applicant's services."]

goods are therefore necessary. Trademark Rule 2.59(b) and TMEP §905.10.

Decision: The refusal on the basis that the drawing of the mark sought to be registered is not a substantially exact representation of the mark as used on or in connection with applicant's goods and the requirement for submission of properly verified substitute specimens demonstrating trademark use of the mark shown in the drawing are affirmed.

E. W. Hanak

G. D. Hohein

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board